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EXAMINER

BLECK, CAROLYN M

ART UNIT PAPER NUMBER

3626

DATE MAILED: 01/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/653,384

Applicant(s)

SHOLEM, STEVEN L.

Examiner

Carolyn M Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the election filed 5 December 2003.

Claims 39-61 are pending.

Election/Restrictions

2. Applicant's election without traverse of Group 9 claims 39-61 in Paper No. 6 is acknowledged.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 45 and 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claim 45, line 45, "the indication" lacks proper antecedent basis. For purposes of applying prior art, "the indication" is being interpreted as an indication.

(B) Claim 46 incorporates the deficiencies of claim 45 through dependency, and is also rejected.

(C) Claim 49, line 1, "the indication" lacks proper antecedent basis. For purposes of applying prior art, "the indication" is being interpreted as an indication.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 39 and 56-57 are rejected under 35 U.S.C. 102(b) as being anticipated by Giannini (5,915,241).

(A) As per claim 39, Giannini discloses a programmed computer system for encoding, documenting, and processing the procedures and billing of health care provider treatments (Abstract, col. 11 lines 2-5):

(a) a terminal including an electronic means for communicating over a network such as the Internet (col. 7 line 55 to col. 8 line 10);

(b) memory (col. 11 line 3 to col. 12 line 22);

(c) central processing unit and a program installed on a computer for (col. 11 line 3 to col. 12 line 22):

- (i) submitting payer identified by the provider to a central database (Figure 1, col. 5 lines 20-35, col. 7 line 55 to col. 8 line 23);
- (ii) retrieving a relative value unit (RVU) conversion factor from the database, wherein the RVU is a value unit given to a particular procedure, good, or service which equates any one service relative to the value of all other services, wherein the conversion factor is used to convert an RVU into a payment amount which is acceptable to all parties, the payer, and the provider (Figure 1, col. 4 line 29 to col. col. 5 line 50, col. 10 lines 20-51); and
- (iii) calculating the relative value unit for at least one insurance claim, wherein the claim includes a medical service or procedure (col. 5 lines 10-30, col. 9 lines 9-60, col. 10 lines 20-51).

(B) As per claims 56 and 57, Giannini discloses an alternative coding system including an operable computer system and databases communicating over the Internet with an electronic means of a provider, such as a computer terminal, wherein the provider is able to access the alternative coding system using the remote terminal (col. 7 line 55 to col. 8 line 10).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 40, 42-43, and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giannini (5,915,241).

(A) As per claim 40, the teachings of Giannini disclosed in the rejection above are incorporated herein.

Giannini fails to expressly disclose the relative value being the net present value.

It is respectfully submitted that using the net present value to value services is a value commonly used in economics.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the net present value within the system of Giannini with the motivation of properly valuing the particular procedure, good, or service, thus ensuring profitability for the health care provider (Giannini; col. 4 line 62 to col. 5 line 9).

(B) As per claim 42, Giannini discloses storing the allowable fees for an insurer (col. 8 lines 10-39). Giannini is silent as to a time delay in payment of fees by a TPP and a percentage of allowable fees paid by the TPP. However, it is respectfully submitted that typically health care providers and insurance companies have data stored in a database regarding the percentage of allowable fees paid by the insurer and the providers also store data on when a provider is paid by the insurance company. The skilled artisan would have found it an obvious modification to the system of Giannini to include this

data with the motivation of valuing a particular procedure, good, or service, thus ensuring profitability for the health care provider (Giannini; col. 4 line 62 to col. 5 line 9).

(C) As per claim 43, the teachings of Giannini disclosed in the rejection above are incorporated herein.

Giannini fails to expressly disclose the relative value is a difference between a net present value of the services provided and a cost of providing the at least one medical service.

It is respectfully submitted that when calculating the relative value, a provider can typically use different calculations to calculate the relative value, and the skilled artisan would have found it obvious to calculate the difference within the system of Giannini with the motivation of properly valuing the particular procedure, good, or service, thus ensuring profitability for the health care provider (Giannini; col. 4 line 62 to col. 5 line 9).

(D) As per claims 45-46, the teachings of Giannini disclosed in the rejection above are incorporated herein.

Giannini fails to expressly disclose the indication of a relative value being one of a plurality of ranked indicators, wherein the ranked indicators are red, orange, and green.

It is respectfully submitted that ranking items and color coding items is a commonly used technique to display information, and the skilled artisan would have

found this an obvious modification to the system of Giannini with the motivation of presenting an view of data for a health care provider to interpret quickly.

9. Claims 41 and 47-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giannini (5,915,241) as applied to claim 39, and further in view of Javitt (5,918,208).

(A) As per claim 41, the teachings of Giannini disclosed in the rejection above are incorporated herein.

Giannini fails to expressly disclose software configured to generate an indication of the relative value as a function of at least one payment pattern of the third party payer.

Javitt discloses showing the relative value being a function of the rates paid by third parties, and the values are shown using graphical interactive screens (Figures 1-14, col. 2 line 63 to col. 4 line 19).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the aforementioned features of Javitt within the system of Giannini with the motivation of allowing a physician to forecast revenues from a payer (Javitt; col. 1 lines 34-57).

(B) As per claim 47, the teachings of Giannini disclosed in the rejection above are incorporated herein.

Giannini discloses storing patient information, such as a patient name (col. 7 line 55 to col. 8 line 10, col. 10 line 20 to col. 12 line 22).

Giannini fails to expressly disclose software configured to generate an indication of whether it would be profitable to accept the patient as a new patient.

Javitt discloses means for projecting revenue for performing medical procedures on a patient based on the rates of the payer (col. 2 line 49 to col. 3 line 29, col. 4 line 5 to col. 10 line 32).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the aforementioned features of Javitt within the system of Giannini with the motivation of allowing a physician to forecast revenues from a payer (Javitt; col. 1 lines 34-57).

(C) As per claim 48, Javitt discloses clicking on a "RVU" button to access the "expected RVU per beneficiary (col. 6 lines 1-12). The motivation for combining Javitt within Giannini is given above in claim 47, and incorporated herein.

(D) As per claims 49-51, Giannini fails to expressly disclose the indication being generated as a function of the expected profitability of the TPP, of whether it would be profitable to enter into a services agreement with the TPP, and of at least one payment pattern of the TPP.

Javitt discloses projecting revenues for providing health care related for a health care indemnity insurance scenario (col. 8 lines 17-67), and showing the relative value

being a function of the rates paid by third parties, wherein the values are shown using graphical interactive screens (Figures 1-14, col. 2 line 63 to col. 4 line 19).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the aforementioned features of Javitt within the system of Giannini with the motivation of allowing a physician to forecast revenues from a payer (Javitt; col. 1 lines 34-57).

10. Claims 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giannini (5,915,241) as applied to claim 39, and further in view of Rensimer et al. (5,845,253).

(A) As per claim 54, the teachings of Giannini disclosed in the rejection above are incorporated herein.

Giannini fails to expressly disclose generating a recommended duration for a primary medical personnel to visit the patient.

Rensimer discloses using a CPT clinical status code used by a health care provider, wherein the CPT code has an associated standard amount of time for a provider to interact with a patient (col. 4 lines 24-33).

At the time the invention was made, it would have been obvious to combine the features of Rensimer within the system of Giannini with the motivation of allowing a physician to better understand the allocation of professional resources used in a given practice during a particular period of time (Rensimer; col. 1 line 63 to col. 2 line 21).

(B) As per claim 55, Giannini and Rensimer do not expressly disclose generating a timer indicating time remaining in the recommended duration.

However, as discussed above, Rensimer discloses using a CPT clinical status code used by a health care provider, wherein the CPT code has an associated standard amount of time for a provider to interact with a patient (col. 4 lines 24-33). It is respectfully submitted that generating a timer is a well known technique used for measuring time. The motivation being to ensure a physician is able to keep within the allocated time for an appointment of a patient.

11. Claims 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giannini (5,915,241) as applied to claim 39, and further in view of Joao (6,283,761).

(A) As per claim 58, the teachings of Giannini disclosed in the rejection above are incorporated herein.

Giannini fails to expressly disclose at least one electronic device configured as one of a wireless access terminal and a wireless interface, and the at least one electronic device further comprising software configured to receive an electronic superbill and automatically send related charges to a third party provider for payment.

Joao discloses a central processing computer, provider computer, and payer computer being capable of transmitting information over a wireless communication network or system (col. 14 line 48 to col. 15 line 58), wherein the provider computer

generates a claim form for submission to at least one of a healthcare payer and a healthcare insurer (col. 43 lines 30-55).

At the time the invention was made, it would have been obvious to combine the features of Joao within the system of Giannini with the motivation of reducing the costs of processing treatment claims and/or claims for healthcare services and/or benefits by performing claims processing electronically (Joao; col. 2 lines 1-12).

In addition, as per the recitation of an "electronic superbill", it is noted that Joao's recitation of a "claim form" is considered to be a form of an "electronic superbill". Further, it is noted that a "superbill" is a commonly used method of recording patient care information in a form.

12. Claims 52 and 59-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giannini (5,915,241) as applied to claim 39, and further in view of Evans (5,924,074).

(A) As per claim 52, the teachings of Giannini disclosed in the rejection above are incorporated herein.

Giannini fails to expressly disclose software configured to generate an indication of when a patient's appointment should be scheduled.

Evans discloses enabling a healthcare provider to schedule a patient appointment using a point and click interface by selecting an appointment data and an appointment time, and wherein the healthcare provider can review prior or future

scheduled appointments by clicking on an appointment button (Figure 2, col. 5 line 29 to col. 6 line 9).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Evans within the system of Giannini with the motivation of quickly and efficiently capturing patient data (Evans; col. 2 lines 20-45).

(B) As per claim 59, the teachings of Giannini disclosed in the rejection above are incorporated herein.

Giannini fails to expressly disclose at least one electronic device being configured as one of a wireless access terminal and a wireless interface, and the at least one electronic device further comprising software configured to transmit to a pharmacy a prescription, billing information, and an address to which the prescription should be delivered.

Evans discloses communicating using a pen computer through a wireless transceiver (Figure 24, col. 12 line 55 to col. 13 line 56), wherein the pen computer is able to transmit a physician's prescription for medication to a hospital or pharmacy (col. 10 line 59 to col. 11 line 8).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Evans within the system of Giannini with the motivation of allowing a remotely located healthcare provider to communicate information to a pharmacy (Evans; col. 1 line 53 to col. 2 line 20).

As per the recitation of “billing information and an address to which the prescription should be delivered”, it is respectfully submitted that any pharmacy would require billing information, for example a patient’s insurance information, and the patient’s address to be included in a prescription submitted by a physician.

(C) As per claim 60, the teachings of Giannini disclosed in the rejection above are incorporated herein.

Giannini fails to expressly disclose software configured to evaluate a use pattern of at least one supply of a medical services provider, evaluate an inventory quantity of at least one supply, evaluate an estimated scheduled appointment use of the at least one supply, and automatically order an appropriate quantity of the at least one supply.

Evans discloses an electronic medical records system providing the capability to analyze utilization of physicians, nurses, staff, and equipment as well as time utilization for patients, such as wait times for referrals, lab results, and physician’s examinations (col. 14 line 42 to col. 15 line 7).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Evans within the system of Giannini with the motivation of allowing a physician to have a complete audit trail of resources used in real-time (Evans; col. 2 lines 20-65).

13. Claims 44, 53, and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giannini (5,915,241) as applied to claim 39, and further in view of Official Notice.

(A) As per claim 44, Giannini fails to expressly disclose the cost of providing at least one medical service being a function of at least one of administrative cost of a medical services provider, an overhead cost of a medical office, a cost for medical office staff salaries, an equipment and supplies cost, and a utilities cost.

However, it is well known that in a business, setting the cost of a product or service would include within the cost calculation, calculating the administrative cost, overhead costs, and costs of staff, equipment, supplies, and utilities.

At the time the invention was made, it would have been obvious to modify the system of Giannini by using the cost calculation with the motivation of properly valuing the particular procedure, good, or service, thus ensuring profitability for the health care provider (Giannini; col. 4 line 62 to col. 5 line 9).

(B) As per claim 53, the teachings of Giannini disclosed in the rejection above are incorporated herein.

Giannini fails to expressly disclose an indication being generated as a function of at least one payment pattern of the TPP with which the patient is associated.

However, it is well known in the art that before a health care provider accepts a patient into the provider's practice, the provider examines the patient's insurance

company to determine whether the practice accepts that insurance company, where accepting or denying an insurance company is based on whether the insurance company pays insurance claims efficiently.

At the time the invention was made, it would have been obvious to modify the system of Giannini by using an indication with the motivation of ensuring a health care provider accepts patients where the provider is ensured they will be reimbursed for services rendered.

(C) As per claim 61, the teachings of Giannini disclosed in the rejection above are incorporated herein.

Giannini does not expressly disclose a biometric identifying device.

However, it is well known in the art to use biometric identifying devices.

At the time the invention was made, it would have been obvious to modify the system of Giannini with a biometric device with the motivation of providing a security mechanism to ensure the privacy of patient data.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches a system and method for correlating medical procedures and medical billing codes (5,325,293), health care payment system utilizing an intensity adjustment factor applied to provider episodes of care (5,819,228), system and method for assessing physician performance (5,924,073),

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apparatus and system for utilization review of medical claims (6,324,516), provider claim editing and settlement system (6,341,265), electronic creation, submission, adjudication, and payment of insurance claims (6,343,271), and method and apparatus for capturing and representing diagnostic, treatment costs, and outcomes information (6,381,576).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

16. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

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(703) 872-9306 or (703) 872-9326 [Official communications]

(703) 872-9327 [After Final communications labeled "Box AF"]


(703) 746-8374 [Informal/ Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th Floor (Receptionist).



CB

December 15, 2003



JOSEPH THOMAS
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